
United States Patent and Trademark Office Proposes Modifications in Practice Before the Board of Patent Appeals and Interferences

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On December 22, 2009, the U.S. Patent and Trademark Office (USPTO) published a notice of proposed modifications to the rules of practice before the Board of Patent Appeals and Interferences (BPAI) in ex parte appeals. The modifications are intended to frame disputes between appellants and examiners more efficiently, to encourage examiners and applicants to resolve disputes without having to proceed with an appeal, and to reduce certain burdens on applicants. The total number of appeals in the USPTO has risen dramatically in the past few years.

The new notice proposes deleting or revising a number of provisions in a June 10, 2008 final rule that has never gone into effect. In particular, the new proposal provides:

- Appeal briefs, reply briefs and requests for rehearing are no longer required to contain jurisdictional statements, tables of contents, tables of authorities, and statements of facts;
- Similarly, briefs no longer need identify which arguments were previously presented to the examiner and which arguments are new; neither must appellants provide a list of technical terms and other unusual words that may be used at an oral hearing;
- Specific formatting and page limits for appeal briefs, reply briefs, and requests for rehearing are removed;

- An examiner will still be permitted to enter a new ground of rejection in an examiner's answer to an applicant's main brief, but the examiner is not allowed to file a supplemental answer to a reply brief;
- Provisions requiring petition to the Chief Administrative Patent Judge for extensions of time or page limits after an appeal brief is filed are deleted; and
- Finally, the proposed rules clarify that the Chief Administrative Patent Judge alone, rather than the Board, may remand an application to the examiner.

This newest proposal to modify the rules governing practice before the Board has an extended history. The USPTO originally published a notice of proposed rule-making in July 2007. A final rule, specifying an effective date of December 10, 2008, was published on June 10, 2008. However, due to issues with the Office of Management and Budget information collection process, the effective date was deferred indefinitely. The new proposal is directed to changes on this never-effective final rule.

Note for practitioners: The USPTO previously indicated in a notice published November 20, 2008 that appeal briefs would be considered compliant by following the requirements of the current rules or the new format in the final rule published June 10, 2008. Because the USPTO is now reconsidering the final rule and potential modifications, ***as of January 21, 2010 the USPTO will no longer accept appeal briefs in the new format – appeal briefs must comply with the current 37 C.F.R. 41.37.***

The USPTO is now seeking public comment on its new proposal. A roundtable discussion will be held on January 20, 2010 and will be available by webcast. Written comments on the proposed revisions to the June 10, 2008 final rule are due on February 12, 2010, and written comments on other matters discussed at the roundtable are due on February 25, 2010.

What any final rule may be, when it will become effective, and what its real effect may be on Board practice and the length of time involved in having an appeal resolved, all remain to be seen.

To follow further developments on this, please visit [Patent Appeals: Proposed BPAI Rule Changes](#) on www.wilmerhale.com.

Authors



Emily R. Whelan

PARTNER

Chair, Intellectual Property
Department

✉ emily.whelan@wilmerhale.com

☎ +1 617 526 6567

James B. Lampert

RETIRED PARTNER

✉ james.lampert@comcast.net

☎ +1 617 526 6000